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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,175	08/10/2001	Robert A. DiChiara JR.	7784-000171	4647
27572	7590	11/19/2003	EXAMINER	
HARNES, DICKEY & PIERCE, P.L.C.				
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ART UNIT			PAPER NUMBER	

1762

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/927,175

Applicant(s)

DICHIARA, ROBERT A.

Examiner

Michael Barr

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-14 and 26-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-14 and 26-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8/03.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Response to Arguments

1. Applicant's arguments and amendments, filed 9/22/2003, have been fully considered and reviewed by the examiner. The examiner acknowledges the cancellation of Claims 20 and 22-24 and the addition of Claims 34-40. Claims 9-14 and 26-40 are pending.

The applicant has argued against the combination of DiChiara and Kourtides stating that there would be no motivation to combine the references, since the Kourtides coating is different than the DiChiara coating and since there is no expectation that improved results would occur by the combination, only equivalent results. The examiner is not persuaded by the applicant's arguments. Kourtides fails to teach that the emissivity modifying agent be a boron compound. The DiChiara reference is merely being applied by the examiner to show that it is known in the art that molybdenum disilicide, silicon carbide, silicon hexaboride, and silicon tetraboride are functionally equivalent as emissivity modifying agents for high temperature ceramics, such as those in DiChiara and Kourtides et al. One of ordinary skill in the art reviewing DiChiara and Kourtides would have found it obvious to substitute silicon hexaboride or silicon tetraboride for the molybdenum silicide in the slurry of DiChiara, with the expectation of providing the functionally equivalent emissivity modifying properties to the slurry, since it is suggested by Kourtides that such material are substantially functionally equivalent as emissivity modifying agents for high temperature ceramics. In regards to the argument that the combination would not be expected to yield improved results, a proper combination does not need to yield improved results, only the expected results. The use of conventional materials to perform their known

functions in a conventional process is considered obvious (*In re Raner* 134 USPQ 343). Also, the substitution of one known equivalent technique for another may be obvious even if the prior art does not expressly suggest the substitution (*Ex parte Novak* 16 USPQ 2d 2041). This shows that improvement is not required for motivation to combine references. In the present case, the combination of DiChiara and Kourtides is substituting conventional and equivalent emissivity modifying agents to perform their known conventional function and such a combination is obvious and such motivation is proper.

Furthermore, the applicant indicates that there is no recognition in the prior art that the boron containing compound achieves the improved results of producing a porous ceramic body stable to higher temperatures than a porous ceramic body produced without the boron containing compound or the properties of Claims 26, as in the applicant's invention. However, as indicated in the previous office action, the applicant has failed to provide claims and evidence commensurate in scope, indicating the argued improvements. Evidence of unobviousness must be commensurate in scope with the claims (*In re Kulling* 14 USPQ 2d 1056, 1058). There is insufficient evidence to indicate unexpected results using materials commensurate in scope with the claims. The only evidence provided by the applicant is an example using specific slurring materials, including boron carbide, and specific substrate material. The claims are not such limited. Also, there is no indication that all materials within the breadth of the claims would yield the same results indicated by the provided examples in the specification. Furthermore, the applicant has not provided a convincing showing of unexpected results using the boron compound in the slurry. If anything, the applicants achieves the expected result, as Kourtides shows that the use of such emissivity agents, such as the boron compounds, achieve thermal

stability to 3000 °F. Emissivity agents are known for providing heat resistance and protection to the ceramic and thus would be expected to provide the porous ceramic body with higher stability to higher temperatures than a porous ceramic body produced without the boron containing compound (emissivity agent). Also, the applicant's showing in the specification (Examples) are not sufficient to indicate unexpected results, as the examples are not commensurate in scope with the claims, as the examples use specific materials, while the claims are broad. There is insufficient evidence to indicate unexpected results using materials commensurate in scope with the claims. Therefore, the examiner is not persuaded by the applicant's arguments and is maintaining the use of the references as previously set forth.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 9-14, 26-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over DiChiara, Jr. et al. in view of Kourtides et al.

DiChiara, Jr. et al. and Kourtides et al. are applied here for the same reasons as given above and in paragraph 4 of the previous office action.

4. Claims 34-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over DiChiara, Jr. et al. in view of Kourtides et al. and Baker et al.

DiChiara, Jr. et al., Kourtides et al., and Baker et al. are applied here for the same reasons as given above and in paragraph 5 of the previous office action.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Barr whose telephone number is 703-305-7919. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on 703-308-2333. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Michael Barr
Primary Examiner
Art Unit 1762

MB
November 17, 2003

A handwritten signature in black ink, appearing to read 'Michael Barr', with a long horizontal flourish extending to the right.